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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,000	06/25/2003	Sean E. Aschen	END920030033US1	4746

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IBM CORPORATION
IPLAW IQ0A/40-3
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EXAMINER

AHN, SANGWOO

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/604,000		ASCHEN ET AL.	
	Examiner		Art Unit	
	Sangwoo Ahn		2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed on 3/7/2006 has been entered. Claims 1, 10, 16, and 19 have been amended. Claims 1 – 20 are pending in this Office Action.

Response to Arguments

Applicant's arguments with respect to claims 1, 10, 16, and 19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Publication Number 2002/0091782 issued to Benninghoff III ("Benninghoff").

With respect to claim 10, Benninghoff discloses,

A system for providing data stored in a mailfile to an application, comprising:

a mailfile stored on a server (Figure 1 element 10), having data stored as documents with sections (Figures 1 – 3, 7, and paragraph 12, 134);

a database for passing a request from an application running on a user workstation (Figure 1 element 700 and 701: recipient computer running outlook), for one of said documents to said mailfile and upon return of said one of said documents,

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converting said one of said documents into an extended markup format (Figure 5, 11, 19, and paragraph 10 – 12, 134);

an authentication directory having authentication records for an application (Figure 5, 12, and paragraph 14, 43, 46, 55, 131); and

mail and calendaring web service (Figure 1 element 10: server performs email delivery and transaction logging (time and date) as "mail and calendaring web service", et seq.) software running on a server different from said workstation, for receiving said request from said application for a document (Figure 5, 19, and paragraph 134), receiving text files in an extended markup format from said database, accessing binary data from said mailfile, creating an object comprising the converted document with said binary data inserted (Figure 5, 11, paragraph 10 – 12, 134), authenticating said application using said directory (Figure 5, 12, and paragraph 14, 43, 46, 55, 131), and sending said object to said application (paragraph 9 – 12, 134).

With respect to claim 11, Benninghoff discloses said database and said software run on different servers (Figure 1)

With respect to claim 12, Benninghoff discloses said extended markup format is XML (paragraph 10 – 12, 134).

With respect to claim 13, Benninghoff discloses said software is adapted to operate without the need of a mail or calendaring client (Figure 1, paragraph 9).

With respect to claim 14, Benninghoff discloses said software is adapted to retrieve said sections of said document from said mailfile (Figure 2 – 3, 5, 7, and paragraph 11 – 12, 134).

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With respect to claim 15, Benninghoff discloses said binary data is an image file (Figure 2 – 3, 5, 7: attachment could be an image file).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 – 4, 6 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2002/0091782 issued to Benninghoff III ("Benninghoff") in view of U.S. Patent Number 5,913,033 issued to Grout ("Grout").

With respect to claim 1, Benninghoff discloses,

A method of providing data to an application, comprising the steps of:

providing a mailfile stored on a server (Figure 1 element 10), of documents having a section and fields (Figure 2 – 3, 7, and paragraph 12, 134);

receiving a request from an application running on a user workstation different from said server, for one of said documents (Figure 5, 19, and paragraph 134);

retrieving said fields of said one of said documents from said mailfile (Figure 5, 11, and paragraph 134);

in response to said fields, retrieving said one of said documents as a markup language document (paragraph 10 – 12, 134);

sending said object to said application (paragraph 9 – 12, 134).

Benninghoff does not explicitly disclose,

inserting at said server, a URL into said markup language document to retrieve said section of said one of said documents;

retrieving at said server, said section from said mailfile in said markup language;
removing at said server, said URL from the retrieved document.

However, Grout discloses,

inserting at said server (Figures 1A – 1B: “server” could be any computer. Client computer document-server computer, and standard-set server computer in Grout all can serve as the “server”), a URL into said markup language document to retrieve said section of said one of said documents (Figures 2A – 2B, column 3 line 13 – 32, column 6 line 60 – 63);

retrieving at said server, said section from said mailfile in said markup language (Figure 2A – 2B, column 3 line 13 – 32);

removing at said server, said URL from the retrieved document and creating an object having said section expanded in the retrieved document (Figure 2A – 2B, column 5 line 45 – 61, column 6 line 60 – column 7 line 38: “removing” step is inherent and well-known. In Grout, URL is automatically removed as the linked object is retrieved).

At the time of the present invention, it would have been obvious to a person of ordinary skill in the data processing art to combine the two references because Grout’s method of inserting a URL and retrieving the designated section to replace the URL would have enabled Benninghoff’s method of providing data to an application to increase the performance of browsing documents and allows downloading of multimedia objects tailored for the user’s language or culture (column 2 line 59 – 64).

With respect to claim 2, Benninghoff discloses said fields are retrieved as an XML document (paragraph 10 – 12, 134).

With respect to claim 3, Grout discloses said markup language is HTML (column 5 line 45 – 61, column 6 line 60 to column 7 line 45)

With respect to claim 4, Benninghoff discloses said one of said documents has a file attachment link (Figure 3 – 4, 7).

With respect to claim 6, Grout discloses said one of said documents has an image tag (column 7 line 1 – 44).

With respect to claim 7, Grout discloses retrieving the image of said image tag, encoding said image, and inserting the encoded image in place of said image tag in the retrieved document (Figure 2A – 2B, column 6 line 60 to column 7 line 45).

With respect to claim 8, Grout discloses said one of said documents has a link to other items in said document (Figure 2A – 2B, column 3 line 13 – 32).

With respect to claim 9, Grout discloses retrieving the content of said link, and inserting said content in the retrieved document at the position of said link (Figure 2A – 2B, column 6 line 60 to column 7 line 45).

Claim 16 – 18 are essentially the same as claim 1 – 3 except they set forth the limitations as “a computer system for exposing a mail and calendaring document to an application” rather than “a method of providing data to an application”, and therefore are rejected for the same reasons as discussed in claim 1 – 3 rejections.

Claim 19 – 20 are essentially the same as claim 1 – 2 except they set forth the limitations as “a computer product” rather than “a method”, and therefore are rejected for the same reasons as discussed in claim 1 – 2 rejections.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benninghoff and Grout, further in view of U.S. Publication Number 2005/0114671 issued to Little et al (“Little”).

Benninghoff and Grout discloses the method of claim 4 as discussed above in claim 4 rejection.

Benninghoff and Grout do not explicitly indicate retrieving attachment, removing said link, and inserting said attachment into said object.

However, Little discloses retrieving attachment, removing said link, and inserting said attachment into said object (paragraph 76). At the time of the present invention, it would have been obvious to a person of ordinary skill in the data processing art to combine the aforementioned references because Little's method of embedding the attachment into the body of the email message would have enabled Benninghoff and Grout's method of providing data to an application to save user's effort and time needed to open and store the attachment, by already displaying the attachment within the body of the email message.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sangwoo Ahn whose telephone number is (571) 272-5626. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sangwoo Ahn
Patent Examiner
AU2166

3/28/2006 SW



HOSAIN ALAM
SENIOR PATENT EXAMINER